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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/998,935	11/30/2001	Zhinng Zhou	56196US011	5911

32692 7590 04/16/2003

3M INNOVATIVE PROPERTIES COMPANY  
PO BOX 33427  
ST. PAUL, MN 55133-3427

EXAMINER

RIBAR, TRAVIS B

ART UNIT

PAPER NUMBER

1711

13

DATE MAILED: 04/16/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/998,935

Applicant(s)

ZHOU ET AL.

Examiner

Travis B Ribar

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 17 March 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1 and 4-33 is/are pending in the application.
- 4a) Of the above claim(s) 16-33 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 and 4-15 is/are rejected.
- 7) ☒ Claim(s) 8 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Claim Objections***

1. Claim 8 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form.

The claim in its current form contains some limitations, such as, "...n-decyl acrylate..." which contain more carbons in the alkyl group than claim 1 allows.

### ***Claim Rejections - 35 USC § 103***

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

3. Claims 1, 4-9, and 11-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yau et al. in view of Everaerts et al.

Paragraph 7 of the office action dated December 12, 2002 contains the text of this rejection.

4. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Yau et al. in view of Everaerts et al. as applied to claim 1 above, and further in view of Peloquin et al.

Paragraph 8 of the office action dated December 12, 2002 contains the text of this rejection.

5. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Yau et al. in view of Everaerts et al. as applied to claim 1 above, and further in view of the abstracts of both JP-02178379A and JP-03281585A.

Paragraph 9 of the office action dated December 12, 2002 contains the text of this rejection.

### ***Response to Arguments***

6. The applicant's newly amended claims now include the limitation that the adhesive composition, when applied to a copper-containing or glass substrate at a thickness of 0.0008 inches and exposed to a temperature of 180°C for 30 minutes, is cleanly removable following heat exposure. With the addition of this property to the claim, the applicant argues that the adhesive in Yau et al. no longer conflicts with the current invention because Yau et al. does not disclose the newly added limitations of claim 1. The applicant points to column 3, lines 31-38 to support the position that the adhesive in Yau et al. will not provide the characteristics of the adhesive that are now present in claim 1.

The examiner respectfully disagrees with this interpretation of the reference. The passage the applicant points to (column 3, lines 31-38) reflects the adhesive's response to being submerged in molten solder at 260°C for about 20 seconds—conditions much

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harsher than the applicant's claimed 180°C exposure (conceivably in air) for 30 minutes. The higher temperature and the difference between exposing an adhesive to hot air and exposing it to molten solder make the conditions in Yau et al. much harsher on the adhesive than the currently claimed conditions. This appears to indicate that since the adhesive does maintain its properties for about 20 seconds under the much harsher conditions, that it likely also would maintain its properties under the less stringent conditions in the current claim.

The examiner also notes examples 33 and 34 in Table 9. Under Condition 9 (see Table 3), the adhesive is cleanly removable from the substrate. This is an adhesive formula that meets the applicant's claim 1 and represents heat exposure within an oven at 180°C. The difference between this testing condition and the applicant's claimed condition is the amount of time the adhesive is held at this temperature. In Yau et al., the adhesive is held at 180°C for 5 minutes, whereas the applicant claims an exposure lasting 30 minutes. This, taken in conjunction with the properties the film has under much harsher testing conditions, appears to further support the position that the adhesive properties the applicant claims are present in Yau et al.

7. The applicant also argues that the adhesive composition in Yau et al. does not meet the definition of 'consisting essentially of,' since it does not have the newly added property of claim 1. The applicant's position is that since the adhesive does not have this property, there exists within the adhesive composition in Yau et al. a material that

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affects the basic and novel characteristics of the adhesive, therefore placing the adhesive outside of the scope of, 'consisting essentially of'.

The examiner respectfully disagrees with the applicant's position that the reference does not possess the applicant's claimed properties and discussed that point above. Since the adhesive meets the structural limitations of claim 1 and also possesses the claimed properties, the examiner maintains his position that Yau et al. discloses an adhesive that 'consists essentially of' the applicant's claimed materials.

With regard to the applicant's argument that the materials added to the adhesive composition in Yau et al. in small amounts (polymer electrolytes in column 3, line 64 to column 4, line 1 and stabilizers (column 4, lines 9-29)) alter the basic and novel characteristics of the adhesive, the examiner cites examples 33 and 34 in Table 9. The adhesive formulae in these examples have additives such as antioxidants and antistatic agents (corresponding to page 7, lines 20-23 of the current specification), but appear to have the applicant's claimed properties nonetheless. This appears to further indicate that the adhesive composition in Yau et al. falls under the scope of, 'consisting essentially of'.

8. The examiner therefore maintains his position on the rejections put forth in this office action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Travis B Ribar whose telephone number is (703) 305-3140. The examiner can normally be reached on 8:30-5:00 Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Seidleck can be reached on (703) 308-2462. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

Travis B Ribar  
Examiner  
Art Unit 1711

TBR  
April 15, 2003

James J. Seidleck  
Senior Patent Examiner  
Center 1700